

REMARKS

The Office Action dated April 14, 2008 has been carefully considered. The Office Action presented a restriction requirement and an election of species requirement. By way of this Amendment and Response, Applicant makes elections and traverses the asserted restriction requirement.

To comply with the restriction requirement, Applicant elects for prosecution of Group I, claims 13-23 drawn to a method for the production of a metal coated steel product, with the traverse below. Applicant respectfully submits, however, that claim 24 should be reinstated for the reasons articulated below. As for the election of species requirement, Applicant elects Category 1, claim 18 ("method of claim 13 under inert atmosphere"); and in Category 2, claim 22 ("method of claim 20 directed to both sides").

Relative to the asserted restriction requirement, it is first submitted that there is no undue burden examining apparatus claim 24 that specifically refers to method claim 13. Moreover, restriction is indicated not to be appropriate in this circumstance under MPEP § 806.05(e) which pertains to restriction practice for process and apparatus for its practice. Under this section, "processes and apparatus for its practice can be shown to be distinct inventions if either or both of the following can be shown: (a) that the process as claimed can be practiced by another maturely different apparatus or by hand; or (b) that the apparatus as claimed can be used to practice another materially different process. Importantly, MPEP § 806.05(e) places a special requirement: "the burden is on the Examiner to provide reasonable examples that recite material differences ... [and] the burden is on the Examiner to document another materially different process or apparatus or withdraw the requirement." In this instance, the Office Action makes no attempt to document a materially different process or apparatus and as such the restriction requirement needs to be withdrawn.

Further, as it would not be a burden anyhow, should the Examiner be able to articulate the materially different process or product employing the process, it should be noted again that there should be no undue burden here as claim 24 refers to method claim 13.

Further, it is noted that means plus function language is used in claim 24 providing a linking function to the recited method steps. Accordingly, withdrawal of the restriction is further appropriate for this reason. Accordingly, Applicant

In re Appln. Of: Marijke De Meyer et al.
Application No.: 10,565,097

respectfully requests that the restriction requirement be withdrawn and that all claims 13-24 be considered together.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Extension of Time and Fee Deficiency

Applicants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that Applicants have inadvertently overlooked the need for a petition and fee for extension of time. If any additional fee is required, or any overpayment is made, in connection with this communication please charge or credit deposit account No. 50-3505.

Respectfully submitted,

/Andrew J. Heinisch/

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Date: May 14, 2008